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10/577,564	04/27/2006	Zhongyi Li	71342-PCT-US/JPW/JW	9729

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COOPER & DUNHAM, LLP
30 Rockefeller Plaza
20th Floor
NEW YORK, NY 10112

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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John P. White
COOPER & DUNHAM, LLP
30 Rockefeller Plaza
20th Floor
NEW YORK NY 10112

In re Application of :
Li et al. :
Serial No.: 10/577,564 :DECISION ON PETITION
IA Filing Date: 27 April 2006 :
Attorney Docket No.:0070/71342-PCT-US/JPW/GJG/LCM

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on 24 December 2009.

BACKGROUND AND DISCUSSION

This application was filed as a national stage application in compliance with 35 USC 371 and as such is subject to PCT unity of invention rules.

On 22 September 2008, the examiner divided claims 1-20, 24, 37, 40-41 and 43, as they were amended on 27 April 2006, into two groups as follows.

> Group I, claim(s) 1-4, 7-20, 24, 37, and 40 drawn to a grain obtained from a rice plant wherein a mutation of an SBEIIa gene and a mutation of an SBEIIb gene reduce the levels or activities of SBEIIa and SBEIIb.
>
> Group II, claim(s) 1-6, 8-14, 17-20, 40-41, and 43, drawn to a grain obtained from a rice plant wherein an introduced nucleic acid inhibits both SBEIIa and SBEIIb.

On 16 December 2008, applicants elected Group II, with traverse.

On 19 February 2009, the examiner acknowledged the election with traverse. The Examiner then re-divided the same claims 1-20, 24, 37, 40-41 and 43, as they were pending on 27 April 2006 into three groups as follows.

Group I, claim(s) 1-6, 8-14, 17, 40, 41 and 43, drawn to a grain obtained from rice wherein the rice grain comprises a reduced level of SBEIIa and SBEIIB and comprises a transgene and a method of producing a rice starch therefrom.

Group II, claim(s) 1-4, 7-17, 24, 37, and 40 drawn to a grain obtained from rice wherein the rice grain comprises a reduced level of SBEIIa and SBEIIB and comprises introducing variations via mutagenizing or identifying null mutants, including Wx^a.

Group III, claim(s) 18-20, drawn to a starch or starch granule and flour.

In this division, it is noted that the claims were switched between Group I and II.

On 23 March 2009, applicants filed an amendment to the claims 15, 18, 20, and elected Group I with traverse.

On 23 July 2009, claims 1-18, 20, 24, 37 and 43 were pending. The examiner acknowledged the election of Group I, considered the traversal and made the restriction requirement FINAL. Claims 7, 15-18, 20, 24 and 27 were withdrawn from consideration as being directed to non-elected inventions. Claims 1-6, 8-14 and 43 were rejected under 35 USC 112, first paragraph for lacking scope of enablement and adequate written description and under 35 USC 103 as being unpatentable over Broglie.

On 24 December 2009, applicants filed a response to the Office action, this petition under consideration, along with an amendment to the claims.

On 12 March 2010, applicants filed an Information Disclosure Statement and an amendment to the claims. Claims 1, 2 4, 6, 8-18, 20, 24, 43, 48-49 and 53-55 are now pending.

The amendment of 12 March 2010 cancelled claims 50-52 and amended claims 8, 9, 15 and 16. Upon discussion with the Supervisory Patent Examiner, it is understood that, following an agreement upon examiner's amendment, claims 1, 2, 4, 6, 8-17, 24, 43, 48-49 and 53-55 would be in condition for allowance. It is further understood that applicant has provided permission of cancellation of claims 18 and 20.

For these reasons, the allowable claims have unity of invention with each other.

DECISION

The petition is **GRANTED** for the reasons set forth above, in view of the upcoming notice of allowance.

The restriction requirement between Groups I, II and III has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.

In view of the withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See In re Ziegler, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The application will be forwarded to the examiner for consideration of the papers filed 12 March 2010 and for preparation of an Office action consistent with this decision consistent with MPEP 1893.05(d) and 821.04(b).

Should there be any questions about this decision, please contact Quality Assurance Specialist Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-0512 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Remy Yucel
Director, Technology Center 1600